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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/605,634	10/15/2003	Gary Rudolph	RUDOP004US	2633
27949	7590	08/04/2004	EXAMINER	
LAW OFFICE OF JAY R. YABLON 910 NORTHUMBERLAND DRIVE SCHENECTADY, NY 12309-2814			WEEKS, GLORIA R	
			ART UNIT	PAPER NUMBER
			3721	

DATE MAILED: 08/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/605,634	RUDOLPH, GARY	
	Examiner	Art Unit	
	Gloria R Weeks	3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 11-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/15/03</u> . | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1-10, drawn to a method and apparatus for converting rotary motion to compound eccentric rotary motion, classified in class 173, subclass 1.

Group II. Claims 11-14, drawn to a method and apparatus for collecting waste products from a rotary motion machine, classified in class 173, subclass 198.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and Group II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the invention of Group I has separate utility such as converting the rotary motion of a machine to eccentric rotary motion using a separate attachment. The invention of Group II discloses the use of a vacuum module to collect waste generated by a rotary motion machine, and does not require the use of the conversion module of Group I. See MPEP § 806.05(d).

3. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Jay Yablon (Reg. No. 30,604) on July 15, 2004 a provisional election was made without traverse to prosecute the invention of Group 1, claims 1-10. Affirmation of this election must be made by applicant in replying

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to this Office action. Claims 11-14 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4 and 6-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Wallin et al. (USPN 4,965,965).

In reference to claims 1-4 and 6-9, Wallin et al. discloses a method and apparatus of converting a rotary motion machine to a compound eccentric rotary machine, comprising: converting an input rotary motion of a given input frequency (9) produced by the rotary motion machine (1, 2) to a compound eccentric rotary motion by attaching a separate rotary motion conversion module (16) to the rotary motion machine (1); the input frequency about a primary rotational centerline (9), the compounded ^{8 12}by an eccentric motion frequency about at least one secondary rotational centerline (15 at 17; figure 1); mating the rotary motion conversion module (16) with an input rotary motion component (15) of the rotary motion machine (1) to receive said input rotary motion.

Claim Rejections - 35 USC § 103

7. Claims 5 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallin et al. (USPN 4,965,965) in view of Howard, Jr. et al. (USPN 5,580,302).

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Regarding claims 5 and 10, Wallin et al. discloses a method and apparatus for converting a rotary motion machine to a compound eccentric rotary motion machine but does not disclose the use of a vacuum. Howard, Jr. et al. teaches a rotary motion machine having a vacuum to collect waste created by a rotary attachment (column 3, line 62-column 4, line 11). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the rotary motion machine of Wallin et al. to include the vacuum of Howard, Jr. et al. for the purpose of preventing waste buildup in the rotary motion machine.

Conclusion

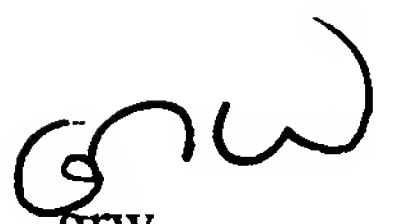
8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Refer to attachment for notice of references cited and recommended for consideration based on their disclosure of limitations of the claimed invention.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gloria R Weeks whose telephone number is (703) 605-4211. The examiner can normally be reached on 7:30 am - 6:00 pm Monday-Thursday.

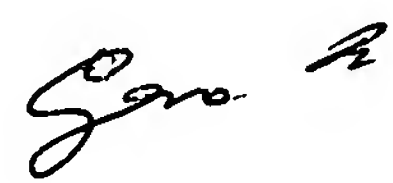
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I Rada can be reached on (703) 305-2187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


grw
July 21, 2004

Gloria R Weeks
Examiner
Art Unit 3721


EUGENE KIM
PRIMARY EXAMINER